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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/011,160	01/20/1998	HAROLD HALL		9528

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SMITH, GAMBRELL & RUSSELL, LLP
1850 M STREET, N.W., SUITE 800
WASHINGTON, DC 20036

EXAMINER	
OCAMPO, MARIANNE S	

ART UNIT	PAPER NUMBER
1723	

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/011,160	HALL, HAROLD	
	Examiner	Art Unit	
	Marianne S. Ocampo	1723	

-- The MAILING DATE of this communication app ars on th cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-16,18,22,23,25-34 and 36-41* is/are rejected.

7)☒ Claim(s) *17,19-21,24 and 35* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The limitation of "**a fluid filter being positioned downstream of the magnet and the second pair of metal plates**" is considered new matter and there is no support or evidence found in the original disclosure for this particular embodiment. **All new matter must be canceled.**

Priority

3. This application repeats a substantial portion of prior Application No. PCT/GB96/01773, filed 7-24-96, and adds and claims additional disclosure (with respect to claim 29) not presented in the prior application. Since this application names an inventor or

inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 12 – 16, 18, 22 – 23, 25 – 30, 33 – 34 and 36 - 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrick (US 5,389,252).

6. With regards to claim 12, Morrick discloses a device for filtering ferromagnetic material suspended in a fluid, comprising:

- a magnet (24) having faces of opposite magnetic polarity, and
- a pair of metal plates (26, in particular in the embodiment wherein there is a metal plate 26 placed on both sides of the magnet, see col. 3, lines 55 - 59), each of the plates (26) being disposed in abutment with a respective one of the faces of the magnet (24), each of the plates

(26) comprising a plurality of recesses (28) about an outer perimeter of the plate (26) to form radially extending magnetic pole pieces which extend beyond an outer perimeter of the magnet faces wherein opposed recesses on the first and second plates define passage means for the fluid and the opposed pole pieces define regions to which the ferromagnetic material is attracted and retained thereto, as in figs. 1 - 3 and cols. 2 - 3.

Although Morrick does not explicitly disclose (since the second plate 26 is not shown in any figures, however, Morrick has disclosed that a second plate 26 exists in col. 3, lines 55 – 59 by the disclosure "metal (disk/plate 26) on both sides of the magnet (24)") that the recesses and pole pieces of the first and second plates (26) being oriented such that they are aligned with respect to each other, it is considered obvious to one of ordinary skill in the art to arrange them in that manner for the simplest design choice in order to allow continuous straight flow of fluid through the recesses of the first and second plates and attraction of ferromagnetic material from the fluid. Furthermore, the case law, ***In re Harza*** [274 F.2d, 124 USPQ 378 (CCPA 1960)] in which a mere duplication of parts (in this instance, duplication of the metal plates from one to two) for a multiplied effect [which includes placing the two plates in a manner such that they are mirror-identical or symmetrical (i.e. having their recesses and pole pieces being aligned)] does not carry any patentable weight or significance unless a new or unexpected result is produced. See also M.P.E.P. section 2144.04 part VI paragraph B.

7. With respect to claim 27, Morrick discloses a magnetic filter device for filtering ferromagnetic material suspended in a fluid, comprising:

- a fluid filter (2),
- a magnet (24) having faces of opposite magnetic polarity, and
- a pair of metal plates (26, in particular in the embodiment wherein there is a metal plate 26 placed on both sides of the magnet, see col. 3, lines 55 - 59), each of the plates (26) being disposed in abutment with a respective one of the faces of the magnet (24), each of the plates (26) comprising a plurality of recesses (28) about an outer perimeter of the plate (26) to form radially extending magnetic pole pieces which extend beyond an outer perimeter of the magnet faces wherein opposed recesses on the first and second plates define passage means for the fluid and the opposed pole pieces define regions to which the ferromagnetic material is attracted and retained thereto, and the filter (2) having a passage means (10) for the fluid which is continuous with the fluid passage through the recesses, as in figs. 1 - 3 and cols. 2 - 3.

Although Morrick does not explicitly disclose (since the second plate 26 is not shown in any figures, however, Morrick has disclosed that a second plate 26 exists in col. 3, lines 55 – 59 by the disclosure "metal (disk/plate 26) on both sides of the magnet (24)") that the recesses and pole pieces of the first and second plates (26) being oriented such that they are aligned with respect to each other, it is considered obvious to one of ordinary skill in the art to arrange them in that manner for the simplest design choice in order to allow continuous straight flow of fluid through the recesses of the first and second plates and attraction of ferromagnetic material from the fluid. Furthermore, the case law, ***In re Harza*** [274 F.2d, 124 USPQ 378 (CCPA 1960)] in

which a mere duplication of parts (in this instance, duplication of the metal plates from one to two) for a multiplied effect [which includes placing the two plates in a manner such that they are mirror-identical or symmetrical (i.e. having their recesses and pole pieces being aligned)] does not carry any patentable weight or significance unless a new or unexpected result is produced. See also M.P.E.P. section 2144.04 part VI paragraph B.

8. Regarding claims 13 and 28, Morrick has disclosed the limitations of claims 12 and 27, respectively above, and also discloses the opposed recesses (defined by notches 28) on the first and second plates (26) also define regions from which the ferromagnetic material is repelled (i.e. the turbulence and flow of fluid through the recesses or notches 28 prevent the attraction (i.e. creates the effect of repelling) of the ferromagnetic material thereto), as in col. 3, lines 20 - 47.

9. Concerning claim 14, Morrick has disclosed the limitations of claim 12 above and also discloses the magnet (24) and the metal plates on both sides thereof (26) being each provided by a central hole which is adapted to receive a tube (20) through which the fluid can pass, the tube (20) providing means for isolating within the device (2) fluid passage in the tube (20) from fluid flow from through the recesses (28), as in figs. 1 – 3 and cols. 2 - 3.

10. With respect to claim 15, Morrick has disclosed the limitations of claim 12 above and further discloses the device further comprising a distribution plate (4) having a plurality of

apertures (10 & 13) which are aligned with the recesses (28 of plate 26 and central hole of plate 26, respectively) of the plates (26) and the apertures (10 & 13) being the only passage means of fluid to said metal plates, as in figs. 1 – 3.

11. Regarding claim 16, Morrick has disclosed the limitations of claim 15 above and also discloses the distribution plate (4), the magnet (24) and the metal plates (26) being each provided with a central hole adapted to receive a tube (20) through which fluid can pass and the tube (20) providing means for isolating within the device, fluid passage in the tube (20) from fluid flow through the recesses (28), as in figs. 1 – 3.

12. With regards to claim 18, Morrick has disclosed the limitations of claim 12 above. Although Morrick does not explicitly disclose the material of construction of the distribution plate (4) being a non-ferromagnetic material, it is considered obvious that since no ferromagnetic material is being trapped by the distribution plate as the fluid passes therethrough, and that in order for a continuous flow of fluid can pass through towards the magnet/disk combination, that the coverplate 4 is most likely formed of a non-ferromagnetic material.

13. Concerning claim 22, Morrick has disclosed the limitations of claim 12 above, and Morrick further discloses the device having means for maintaining the recesses (28) and the apertures (10) in alignment, in the form of the threads (13) on the tube (20), as in fig. 3.

14. With regards to claim 23, Morrick has disclosed the limitations of claim 12 above, and Morrick discloses the magnet (24) comprising a magnetic material which will generate a magnetic force/field between the metal plates (26) of sufficient strength to attract ferromagnetic material from fluid passing therebetween, as in cols. 2 – 3.

15. With respect to claims 25 - 26, Morrick has disclosed the limitations of claims 12 and 15, respectively above, and Morrick also discloses the device further comprising a housing having a means at one (upper) end for receipt by a containing means of the fluid, the containing means (22) comprising an input means (inlet for unfiltered fluid) and output means (outlet for filtered fluid) and the housing having means at the other (lower) end for receiving a fluid filter (2), an output (16) of which fluid filter (2) is continuous with a fluid passageway passing through an aperture (central hole) in the magnet (24) and also continuous with the input means (outlet for filtered fluid) to the containing means (22) and said output means (inlet for unfiltered fluid) from the containing means being continuous in the recesses (28) in the metal plates (26), as in figs. 1 – 3.

16. Concerning claim 29, Morrick has disclosed the limitations of claim 27 above, and Morrick further discloses the fluid filter (2) being positioned downstream of the magnet (24) and the second one of the pair of metal plates, as in fig. 3.

17. With respect to claim 29, previously in the last office action, the limitation "*said **second pair** of metal plates*" in lines 2 – 3, has been considered to be unclear and lacks proper antecedent basis since there is no second pair of metal plates so far been mentioned prior to this claim and there is only one pair (i.e. comprised of the first and second plates) of metal plates. The examiner has interpreted this limitation to contain some typographical errors in which the limitation should have been written as "said second one of the pair of metal plates". The applicant has failed to argue or provide any sort of amendment with regards to this rejection, and therefore, the examiner has considered acquiescence on the part of the applicant, which means that the previous interpretation that the abovementioned limitation should have been written as "the second one of the pair of metal plates" is deemed to be the correct and proper claim limitation.

18. With regards to claim 30, Morrick also discloses a process for filtering ferromagnetic material from a fluid in which the material is suspended comprising passing the fluid through a device for filtering ferromagnetic material from a fluid which the material is suspended, the device comprising a magnet (24) and a pair of metal plates (26, at least one is shown, however, in another embodiment where there is two metal disks (i.e. two metal plates 26) on both sides of the magnet for an increased magnetic strength for magnetic filtering, as in col. 3, lines 55 - 59), and the magnet (24) having faces of opposite magnetic polarity and each of the plates (26) being disposed in abutment with a respective one of the magnet faces (sides) and each plate comprising a plurality of recesses (28) about an outer perimeter of the plate (26) to form radially extending

magnetic pole pieces which extend beyond an outer perimeter of the magnet faces and the recesses of the plates (26) defining passage means for the fluid and the pole pieces thereof defining regions to which the ferromagnetic material is attracted to and retained, as in cols. 2 – 3 and figs. 1 – 3. Although Morrick does not explicitly disclose (since the second plate 26 is not shown in any figures but actually disclosed that a second plate 26 exists in col. 3, lines 55 – 59 by the disclosure "metal (disk/plate 26) on both sides of the magnet (24)") that the recesses and pole pieces of the first and second plates (26) being oriented such that they are aligned with respect to each other, it is considered obvious to one of ordinary skill in the art to arrange them in that manner for the simplest design choice in order to allow continuous flow of fluid through the recesses of the first and second plates and attraction of ferromagnetic material from the fluid. Furthermore, the case law, ***In re Harza*** [274 F.2d, 124 USPQ 378 (CCPA 1960)] in which a mere duplication of parts (in this instance, duplication of the metal plates from one to two) for a multiplied effect [which includes placing the two plates in a manner such that they are mirror-identical or symmetrical (i.e. having their recesses and pole pieces being aligned)] does not carry any patentable weight or significance unless a new or unexpected result is produced. See also M.P.E.P. section 2144.04 part VI paragraph B.

19. Concerning claim 33, Morrick discloses a device for filtering ferromagnetic material from a fluid in which the (ferromagnetic) material is suspended comprising a magnet (24) having a first face (upper side) and a second face (opposite/lower side) with the faces being of opposite magnetic polarity, a first plate (26) magnetically fixed to the first face (upper side) of the magnet

(24) and a second plate (mirror image/identical plate/disk to the first disk 26, not shown) magnetically fixed to the second face (opposite/lower side) of the magnet (24), as in cols. 2 – 3 ("with metal (plates) on both sides of the magnet ", as in col. 3, lines 58 – 59), wherein the first and second plates (26) both have a plurality of recesses (28) about an outer perimeter of the plates to form radially extending pole pieces extending beyond an outer perimeter of the first and second faces of the magnet (24) and the recesses defining passages for the fluid and the pole pieces defining regions to which the ferromagnetic material is attracted and retained, as in cols. 2 – 3 and figs. 1 – 3. Although Morrick does not explicitly disclose [since the second plate 26 is not shown in any figures but disclosed that a second plate 26 exists in col. 3, lines 55 – 59 by the disclosure "metal (disk/plate 26) on both sides of the magnet (24)"] that the recesses and pole pieces of the first and second plates (26) being oriented such that they are aligned with respect to each other, it is considered obvious to one of ordinary skill in the art to arrange them in that manner for the simplest design choice in order to allow continuous flow of fluid through the recesses of the first and second plates and attraction of ferromagnetic material from the fluid. Furthermore, the case law, ***In re Harza*** [274 F.2d, 124 USPQ 378 (CCPA 1960)] in which a mere duplication of parts (in this instance, duplication of the metal plates from one to two) for a multiplied effect [which includes placing the two plates in a manner such that they are mirror-identical or symmetrical (i.e. having their recesses and pole pieces being aligned)] does not carry any patentable weight or significance unless a new or unexpected result is produced. See also M.P.E.P. section 2144.04 part VI paragraph B.

20. With respect to claim 31, Merrick has disclosed the limitations of claim 33 above, and further disclose a process for filtering ferromagnetic material from a fluid in which the ferromagnetic material is suspended, comprising passing the fluid through the device as in claim 33 above, as in cols. 1 – 4.

21. Regarding claim 34, Morrick discloses the recesses in the first and second plates (26) open out at spaced intervals about a peripheral edge of the plates, as in figs. 1 – 2.

22. With regards to claims 36 – 38, Morrick has disclosed the limitations of claim 33 above, and Morrick further discloses the recesses and the pole pieces of the first and second plates being of common configuration. Here the examiner has considered them to be mirror image or identical to each other, since there is no teaching by Morrick that the metal plates (26) on both sides of the magnet (in col. 3, lines 55 – 59) are different in any way from each other, so therefore, they are of the same/common configuration.

23. Concerning claim 39, Morrick has disclosed the limitations of claim 33 and, Morrick also discloses the metal plates (26) being releasably fixed to the magnet and in direct contact with the magnet (24), as in figs. 1 – 3 and in cols. 2 – 4.

24. With respect to claim 40, Morrick discloses a method of filtering ferromagnetic material from a fluid in which the (ferromagnetic) material is present, comprising passing the

ferromagnetic material together with the fluid through the device according to claim 34 above, as in cols. 1 – 4 and in figs. 1 – 3.

25. Regarding claim 41, Morrick further disclose a method of assembling the device according to claim 34 above, comprising fixing the first and second plates (26) to (both sides of) the magnet, as in cols. 1 – 4.

Allowable Subject Matter

26. Claims 17, 19 – 21, 24, 32 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

27. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art is Morrick (US 5,389,252). Morrick has failed to disclose or rendered obvious a device having the combination of limitations recited in claims 12 and 15 - 17 including the limitation of the tube having an outer face being provided with a recess which can receive a retaining means which is able to keep the distribution plate in abutment with an axially closer of the metal plates, as in claim 17, and a device having the combination of limitations recited in claims 12 and 19 including the limitation of each of the recesses being provided with one or a plurality of slots, as in claim 19, and a device having the combination of limitations

recited in claims 12 and 20 including the limitation of an outer edge of each of the pole pieces further provided with one or a plurality of slots, as in claim 20, and a device having the combination of limitations recited in claims 12 and 21 including the limitation of the outer edges of the facing pole pieces being curved towards one another, as in claim 21, and a device having the combination of limitations recited in claims 12 and 24 including the limitation of the metal plate which is impinged first by fluid flow through the device being thicker than the other metal plate through which the fluid leaves the device, as in claim 24, and a device having the combination of limitations recited in claim 32 including the limitation of each of the recesses and an outer edge of each of the pole pieces further provided with one or a plurality of slots, as in claim 32, and lastly, a device having the combination of limitations recited in claims 33 and 35 including the limitation of the pole pieces having formed therein radial slots, as in claim 35.

Response to Amendments and Arguments

28. Applicant's arguments filed 7-23-03 have been fully considered but they are not persuasive. With regards to the argument and assumption made by the applicant that the other metal disk being referred to by Morrick in col. 3, lines 55 – 59, being that of the cover plate (4, which the applicant has assumed to be formed of a metallic material but was not disclosed by Morrick), is incorrect. First of all, the device as disclosed by Morrick would not operate properly if applicant's assumption would be followed by having the coverplate (4) to be metallic. The magnet would magnetized the coverplate and eventually the inlet holes (10) on the plate

would not let any fluid pass through the filter (2) since all ferromagnetic material has already been attracted and thereby covering those inlet holes (10). Secondly, a broader interpretation of the disclosure of Morrick (col. 3, lines 55 – 59) would have a person of ordinary skill in the art increase the magnetic strength by doubling not only just a metal disk (26), but the combination of a metal-magnet (26 & 24) on top of the first one shown, and this would provide, the second one of the pair of metal plates, with one plate abutting one side/face of the (first) magnet. This makes the assertion made by the examiner that the coverplate (4), which the examiner has considered to be equivalent to the distribution plate of the claimed invention to be made of non-ferromagnetic material to be consistent.

29. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the two plates having *opposite polarity* and/or *not identical*, as in page 7, lines 4 - 8) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

30. It is true that Morrick teaches the presence of the particle-collecting disk (26) creates turbulence. First of all, Morrick does not teach the cover plate (4) to be metallic and would not be operative to serve as another particle-collecting disk like metal plate 26, as assumed by the applicant. To make the cover plate (4) metallic and work as a second particle-collecting disk (to

meet the disclosure of having another metal on the other side of the magnet to create further turbulence and thus trapping more ferromagnetic materials), would prevent any fluid from going into the fluid filter (2), and therefore would not meet operate as intended by Morrick. It makes better sense to have another disk like plate 26 in addition to the magnet-plate/disk combination, or even having another magnet-disk combination on top of the one already shown in the figures. With the embodiment of having more than one magnet-disk combination, there would be at least two plates, with one plate on each side of a magnet.

31. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

32. Since the same prior art and the same rejections have been set forth as in the last office action, **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (703) 305-1039. The examiner can normally be reached on Mondays to Fridays from 8:00 A.M. to 4:30 P.M..

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

35. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MSO
M. S.O.

W. L. WALKER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700